



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,341	03/09/2000	David Leigh Donoho	UNIV0001	3293
22862	7590	04/26/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			WINDER, PATRICE L	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/522,341	Applicant(s) DONOHO ET AL.	
	Examiner Patrice Winder	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 and 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 24-36, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-16-06</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-14, 24-25, 29-35, 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso et al., USPN 6,047,327 (hereafter referred to as Tso).

3. Regarding claim 1, Tso taught in a system including an advice consumer for gathering broadcast information from a communications medium and a reader associated with said advice consumer for determining relevance of said broadcast information (abstract), a communications system comprising:

an advice provider which broadcast information over a communications medium to target situations based on an arbitrary combination of computationally verifiable conditions of an advice computer and its environment (column 13, lines 45-53);

wherein said advice consumer is advised of said information only if said information meets certain predetermined relevance criteria as determined by said reader (column 10, lines 41-47);

wherein said advice provider broadcast highly targeted advice the relevance of which to an advice consumer is determined by said reader without comprising individual

Art Unit: 2145

privacy and without learning of identity and attributes of said advice consumer (column 13, lines 59-64, column 21, lines 35-51); and

wherein said environment includes data of a sensitive or private nature (column 13, lines 53-58).

4. Regarding dependent claim 2, Tso taught said relevance criteria further comprising:

a set of any of demographic, biologic, geographical, and other empirical models used to infer statistically that a certain condition is highly likely to be true, even when it can not be verified by direct calculation, measurement, or formal logical deduction, by using any of the information which may be publicly available, information present in a user profile, information directly measurable, or information available from third parties (column 13, lines 29-34).

5. Regarding dependent claim 3-4, Tso taught said data comprises financial data and transaction data (column 10, lines 62-66).

6. Regarding dependent claim 7, Tso taught the system further comprising:

an inspector library containing executable code which is invoked as part of a continual relevance evaluation process (column 10, lines 41-47); and

one or more remote inspector methods for remotely performing any of mathematic-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage device, and querying said communicating devices (column 10, lines 41-47).

Art Unit: 2145

7. Regarding dependent claim 8, Tso taught said one or more remote inspector methods comprising any of medical records inspectors, remote financial records inspectors, and remote drug prescription inspectors (column 10, lines 62-66).
8. Regarding dependent claim 9, Tso taught said one or more remote inspector methods comprise server side components and client side components (column 7, lines 10-15, column 14, lines 16-34).
9. Regarding dependent claim 10, Tso taught said one or more remote inspector methods comprise server side components for providing remote information access (column 7, lines 10-15).
10. Regarding dependent claim 11, Tso taught a consumer receives advice via said remote information access and said consumer's personal information is included in said server side components, only if said consumer authorizes inclusion of said consumer's personal information in said server side components (column 21, lines 52-60).
11. Regarding dependent claim 12, Tso taught a system further comprising:  
means for consumer subscribing to advice sites which make use of said remote inspectors (column 21, lines 52-60).
12. Regarding dependent claim 13, Tso taught a remote inspector method on a consumer machine establishes a connection with an information server and performs one or more queries to determine if relevant information is present on said information server with regard to said consumer (column 24, lines 20-27), and wherein information is gathered by said server (column 11, lines 58-64).

13. The language of claims 24-25, 28-34 is substantially the same as the language of claims 1-3, 6-13, above. Therefore, claims 24-25, 28-34 are rejected on the same rationale as previously rejected claims 1-3, 6-13, above.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 5-6 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso in view of Tjaden, USPN 5,915,238 (hereafter referred to as Tjaden).

17. Regarding dependent claims 5 and 26, Tso does not specifically teach said data comprise health or medical data. However, Tjaden taught data comprise health or medical data (column 2, lines 42-50). It would have been obvious to one of ordinary

Art Unit: 2145

skill in the art at the time the invention was made that Tjaden's health data in Tso's system for delivering Infobites would have expanded system utility. The motivation would have been to include information that better reflects a user's interest.

18. Regarding dependent claim 6 and 27, Myers taught said relevance criteria comprise assertions that certain combinations of prescription drugs, certain interactions between genetic or blood type information or other personal medical history and certain behavior or illness or drug prescriptions (column 2, lines 50).

19. Claims 14-15 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso in view of Loeb et al., USPN 5,245,656 (hereafter referred to as Loeb).

20. Regarding dependent claim 14 and 35, Loeb taught a connection between said client and said server is secured by a cryptographic protocol (column 5, lines 38-48). ). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Loeb's cryptographic protocol in Tso's system for delivering Infobites would have ensured client privacy. The motivation would have been to provide private channels of information.

21. Regarding dependent claims 15 and 36, "Loeb taught the identity of client requesting information is authenticated by a server using an authentication protocol (column 5, lines 38-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Loeb's authentication protocol in Tso's system for delivering Infobites would have ensured client privacy. The motivation would have been to provide private channels of information.

***Response to Arguments***

22. The affidavit filed on February 10, 2006 under 37 CFR 1.131 is sufficient to overcome the Hunt and Wagner references.

***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

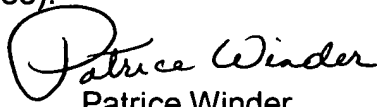
- a. Reilly et al., USPN 5,740,549: taught an information distribution system which disseminates information to subscribers based on categories and subcategories of topics which are of interest to the subscribers; and
- b. O'Toole, Jr. et al., USPN 6,279,112 B1: taught broadcasting or multicasting information pertaining to a personal profile or a user.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrice Winder  
Primary Examiner  
Art Unit 2145

April 21, 2006